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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,854	04/21/2004	Peter Stadler	A-2408	6217
24131	7590	04/25/2005		
LERNER AND GREENBERG, PA			EXAMINER	
P O BOX 2480			FUNK, STEPHEN R	
HOLLYWOOD, FL 33022-2480			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/828,854	STADLER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Stephen R. Funk	2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 March 2005.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17, 19, 20, 22, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 1-12 is/are allowed.
- 6) Claim(s) 13-17, 19, 20, 22, 24 and 25 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

Claims 1 - 17, 19, 20, 22, 24, and 25 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed. Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13 - 17, 19, 22, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeMoore et al. (US 5,651,316) in view of Sismanis et al. (US 6,042,888).

DeMoore et al. teach a printing method comprising providing a first ink system (column 5 lines 49 - 59, column 6 lines 64 - column 7 line 13, paragraph bridging columns 15-16) and a second radiation curing offset ink system (column 5 lines 40 - 43 and column 7 lines 14 - 39), printing a printing material in a combined printing process (column 1 lines 11 - 17), printing with the first ink system (10) onto a first printing area, printing with the second ink system (52) onto a second printing area, and subsequently completely covering the first and second printing areas with a closed layer of transparent clear varnish (column 1 lines 15 and 46 - 55, column 6 lines 49

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- 54, column 16 line 64 - column 17 line 4, and column 18 lines 49 - 61). It is inherent that the protective layer of DeMoore et al. is clear since, otherwise, the first and second printing areas would not be viewable after the protective layer is applied at the end of the printing process. DeMoore et al. do not specifically teach that the first printing area "adjoins" the second printing area.

Sismanis et al. teach a similar method wherein the first printing area adjoins the second printing area (column 2 lines 65 - 66, column 4 lines 64 - 67, column 5 lines 17 - 23 and 28 - 31, column 6 lines 5 - 7, and column 7 lines 41 - 42). Further note the clear protective layer of Sismanis et al.

It would have been obvious to one of ordinary skill in the art to provide the method of DeMoore et al. with the step of printing the second area adjoining the first printing area in view of Sismanis et al. so as to view the first, metallic ink.

With respect to claims 14 and 15 see column 3 lines 1 - 5, column 5 lines 37 - 55, and column 16 lines 40 - 44 of DeMoore et al.

With respect to claims 16 and 17 see the paragraph bridging columns 6 and 7, the paragraph bridging columns 15 and 16, and column 16 lines 28 - 39 of DeMoore et al.

With respect to claim 19 see column 5 lines 40 - 43 and column 7 lines 14 - 39 of DeMoore et al.

With respect to claim 22 see column 1 lines 15 and 46 - 55, column 6 lines 49 - 54, column 16 line 64 - column 17 line 4, and column 18 lines 49 - 61 of DeMoore et al.

With respect to claim 24 see column 6 line 64 - column 7 line 38 and Figures 1 and 3 of DeMoore et al.

With respect to claim 25 see column 6 line 19+ of DeMoore et al.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeMoore et al. in view of Sismanis et al. as applied to the claims above, and further in view of Kistler et al. (US 5,791,251). DeMoore et al. do not teach using a specially mixed ink. Kistler et al. teach using a specially mixed ink different from the colors black, cyan, magenta, and yellow in an offset printing press. See column 2 lines 8 - 13, column 4 lines 28 - 30, and column 5 lines 61 - 65 of Kistler et al. It would have been obvious to one of ordinary skill in the art to provide the method of DeMoore et al., as modified by Sismanis et al., with the step of using a specially mixed color in view of Kistler et al. so as to obtain special effects on the printing material.

Claims 1 - 12 are allowed. With respect to the allowability of parent claim 1 see applicant's Remarks filed August 23, 2001 and the Office action mailed October 16, 2001 in parent application Serial No. 09/531,344.

Applicant's arguments filed March 18, 2005 have been fully considered but they are not persuasive. Applicant argues that DeMoore et al. only teach overprinting the second ink on the first ink and therefore specifically teach away from the proposed combination. Although DeMoore et al. do teach the advantages of radiation curing the first ink so as to overprint a second ink, the method of DeMoore et al. need not be necessarily limited to always printing a second ink on top of a first ink. First, this would presume that a first printed ink would never be present in the final image. If the first color printed was the desired color, then one of ordinary skill in the art would not print over the first color with subsequent colors. See the paragraph bridging columns 5 and 6 of DeMoore et al., for example. Second, drying or curing previously printed inks also prevents smearing of the inks as the sheets are transferred between printing

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units or just by mere contact with downstream blanket cylinders. That is, drying or curing previously printed inks prevents smearing even when not overprinting a second ink on top of a first ink. See column 1 lines 32 - 45 of DeMoore et al. Third, one of ordinary skill in the art would not overprint reflective metallic inks with subsequent opaque inks. See column 18 lines 22 - 48 of DeMoore et al. and column 2 lines 65 - 66, column 4 lines 64 - 67, column 5 lines 17 - 23 and 28 - 31, column 6 lines 5 - 7, and column 7 lines 41 - 42 of Sismanis et al. Sismanis et al. provide very specific teachings that second inks should not be printed over first metallic inks, but rather adjacent to. Even if DeMoore et al. teach overprinting the first ink with a second ink, it would have been *prima facie* obvious to one of ordinary skill in the art in view of the specific and persuasive teachings of Sismanis et al. not to print a second opaque ink over a first metallic ink whereby the reflectivity of the metallic ink would be destroyed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen R. Funk whose telephone number is (571) 272-2164.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Hirshfeld, can be reached at (571) 272-2168.

The fax phone number for ALL official papers is (703) 872-9306. Upon consulting with the examiner *unofficial* papers only may be faxed directly to the examiner at (571) 273-2164.

SRF  
April 19, 2005

A handwritten signature in black ink that reads "Stephen Funk". The signature is fluid and cursive, with "Stephen" on top and "Funk" below it, both starting with a capital letter.